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| 10/824,940 | 04/15/2004 | Max Stern | STN.PAT.25 | 7551 |
| 30733 | 7590 | 02/29/2008 | EXAMINER | |
| Jeffrey C. Maynard 154 Barbara Road Severna Park, MD 21146 | | | AHMED, MASUD | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3714 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,940

Applicant(s)

STERN, MAX

Examiner

MASUD AHMED

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CI/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: at step (F) if certain condition is not met, applicant is claiming to repeat steps (D) through (F) where (F) itself is part of the step (F). Applicant should add an additional step to separate repeating step from step (F). Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At step (F) if certain condition is not met, applicant is claiming to repeat steps (D) through (F), which is also part of step (F); therefore it is not clear how the steps should be followed.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennington (US 2004/0043807).

Regarding claims 1, 8 and 13, Pennington teaches a video poker game system having following limitations:

Providing a set of contest elements for a poker game with playing indicia on the surface; displaying an initial poker hand; displaying a predetermined number of contest elements to each participant; evaluating the combination of elements in each slot or poker hands for winning hand with the first table of values (para 0054); if its not an winning hand then display number of contest elements at a predetermined number of times (para 0056); give players option to elect or discard the cards for the second hands of play without additional wagers; determine the winning combination of the symbol and award the player accordingly (para 0009, 0010, 0012). However, Pennington is silent on disclosing additional hand of symbol elements to the player and if its non-winning combination then letting player to elect or discard the choices of cards for a winning hand.

Pennington's teaching includes players given second chance if the player is not satisfied with the first initial hand, which is merely an obvious variation of giving players multiple chances to win a poker hand. Therefore it would have been obvious to ordinary skilled artisan at the time of invention to include multiple chances instead of just giving player once second chance to win a poker hand and create pay variation so that can create excitement among players and at the same time makes the game profitable for the casino.

Regarding claim 2, Pennington teaches players are paid if the winning combination is matched (para 0054), which is considered to be first table of value and

second chance winning combination is considered to be second table of values (para 0056), since the winning combination both can be different from each other.

Regarding claim 3, Pennington teaches winning combination are based on an accepted standard poker hand ranking (para 0051).

Regarding claim 4, Pennington teaches the combinations are determined for five card poker hands (para 0051).

Regarding claim 5, Pennington teaches a single deck is used for each five-card poker hand, however Pennington does makes a suggestion of having different number of cards or decks can be used (para 0051, para 0052).

Regarding claim 6, Pennington teaches each hand of cards are associated with its own deck of cards (para 0052).

Regarding claim 7, Pennington teaches the video poker game system can be played on an electro-mechanical or electronic video game machine (FIG 1 B), and a hand-held mechanical or electrical device is an obvious variation of this invention.

Regarding claim 9, Pennington teaches a means for player to wager on the machine (FIG 1B #12).

Regarding claim 10, Pennington teaches a touch screen control device where player can select indicia (para 0049).

Regarding claims 11 and 12, Pennington teaches player can select indicia by pressing buttons and display is an electromechanical device (para 0051).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MASUD AHMED whose telephone number is (571)270-1315. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm, Alt Fri, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571 272 7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

/M. A./
Examiner, Art Unit 3714

